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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,402	11/22/2000	Glenn F. Evans	MS1-688US	2724
22801	7590	06/01/2006	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			BOCCIO, VINCENT F	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,402

Applicant(s)

EVANS ET AL.

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/20/06 "131" & 5/15/06 IDS.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/20/06, 12/14/05, 5/15/06</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2621.

Response to Arguments

1. Applicant's arguments filed 1/20/06 have been fully considered but they are not persuasive, see below.

37 CFR 1.131 Has Been Considered Ineffective

1. The declaration filed on 1/20/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the reference.

2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the 5/4/2000 reference US 6,798,976.

3. The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the 5/4/2000 reference US 6,798,976.

There is no provided evidence, but, merely a statement with respect to reduction to practice or "reduced to practice at least by the release of the Beta 2 release of Windows Millennium operating system", there exist no evidence with respect to actual reduction to practice of the claimed, invention, requires that the invention, must have been sufficiently tested to demonstrate that it will work for its intended purpose, there exist no evidence with respect to demonstrating that the claimed invention was working as of the Beta releases 2, 2.5 or 3.

EXPERIMENTAL USE ENDS WHEN THE INVENTION IS ACTUALLY RE-DUCED TO PRACTICE

Experimental use "means perfecting or completing an invention to the point of determining that it will work for its intended purpose." Therefore, experimental use "ends with an actual reduction to practice." RCA Corp. v. Data Gen. Corp., 887 F.2d 1056, 1061, 12 USPQ2d 1449, 1453 (Fed. Cir. 1989). If the examiner concludes from the evidence of record that an applicant was satisfied that an invention was in fact "complete," awaiting

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approval by the applicant from an organization such as Underwriters' Laboratories will not normally overcome this conclusion. *InterRoyal Corp. v. Simmons Co.*, 204 USPQ 562, 566 (S.D.N.Y. 1979); *Skil Corp. v. Rockwell Manufacturing Co.*, 358 F. Supp. 1257, 1261, 178 USPQ 562, 565 (N.D.Ill. 1973), *aff'd in part, rev'd in part sub nom. Skil Corp. v. Lucerne Products Inc.*, 503 F.2d 745, 183 USPQ 396, 399 (7th Cir. 1974), *cert. denied*, 420 U.S. 974, 185 USPQ 65 (1975).

See MPEP § 2133.03(c) for more information of what constitutes a "complete" invention. The fact that alleged experimental activity does not lead to specific modifications or refinements of an invention is evidence, although not conclusive evidence, that such activity is not within the realm permitted by the statute. This is especially the case where the evidence of record clearly demonstrates to the examiner that an invention was considered "complete" by an inventor at the time of the activity. Nevertheless, any modifications or refinements which did result from such experimental activity must at least be a feature of the claimed invention to be of any probative value. In *re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979).

With respect to evidence provided the record fails to include evidence of completing experimental use, thereby establishing reduction to practice, after experimental use ends.

Further the questions, experimental use by all performing experimental use, who are they and how many Beta testers were there??

There is no evidence to completion of testing by any Beta testers, showing evidence of either, "completion of testing and evaluation", by all testers, description of operations of intended {working or not}, when testing was completed/ended by any beta testers or an evaluation of test results indicating that the Beta version 2 or Beta 2.5 or Beta 3, was operating with respect to the claimed operations and functions, by at least one, or a completion of testing by all or merely at least one tester indicating working operations, of the claimed subject matter, one of more evidence of the above deficiencies, may overcome the prior art reference with respect to the 131 declaration provided.

The examiner incorporates by reference the last action against the claims 1-12.

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumagari et al. (US 6,798,976) in view of Lau et al. (US 6,525,746).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Fax Information

Any response to this action should be faxed to:
(571) 273-8300, for communication as intended for entry,
this Central Fax Number as of 7/15/05

Contact Information

Any inquiry concerning this communication or earlier
communications should be directed to the examiner of
record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00
PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
5/27/06


VINCENT BOCCIO
PRIMARY EXAMINER